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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/712,872	11/15/2000	Ralph W. Wright JR.	A148 1596	9345

7590 12/16/2002

Womble Carlyle Sandridge & Rice PLLC
P O Box 7037
Atlanta, GA 30357-0037

EXAMINER

NGUYEN, KIMBERLY T

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 12/16/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

AS-76

Office Action Summary	Application No. 09/712,872	Applicant(s) WRIGHT ET AL.	
	Examiner Kimberly T. Nguyen	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>9</u> . | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Response to Amendment

This action is in response to the amendment submitted on October 1, 2002. It is acknowledged that claims 4 and 29-55 are canceled.

Claim Rejections - 35 USC § 112

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Due to Applicants' amendments and remarks, the previous rejections of claims 5, 8, 16-17, 19-22, 25, and 28 under 35 USC 112, 2nd paragraph are withdrawn.

Claim Rejections - 35 USC § 103

Claims 1-3 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ehrhart et al., U.S. Pat. No. 5,543,232 in view of Shalov et al., U.S. Pat. No. 5,830,937 as previously stated in the Office Action submitted on October 1, 2002.

As to the newly added limitation to claim 1 "wherein the topcoat comprises a composition selected from the group consisting of a UV light curable layer, electron beam curable layer, and combination thereof," Ehrhart et al. shows a floor covering comprising a substrate and UV radiation cured acrylated polyester wear layer (top layer) (Abstract and column 9, line 29 to column 10, line 6).

Claims 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shalov et al., U.S. Pat. No. 5,830,937 in view of Ehrhart et al., U.S. Pat. No. 5,543,232 as previously stated in the Office Action submitted on October 1, 2002.

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Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shalov et al., U.S. Pat. No. 5,830,937 in view of Ehrhart et al., U.S. Pat. No. 5,543,232 in further view of Sawka et al., U.S. Pat. No. 5,405,675 as previously stated in the Office Action submitted on October 1, 2002.

Claims 12-21, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shalov et al., U.S. Pat. No. 5,830,937 in view of Ehrhart et al., U.S. Pat. No. 5,543,232 as previously stated in the Office Action submitted on October 1, 2002.

As to the newly added limitation to claim 12 "wherein the topcoat and radiation cured pigmented wear layer comprise a composition selected from the group consisting of a UV light curable layer, electron beam curable layer, and combination thereof," Shalov et al. shows a surface covering comprising a substrate and UV light radiation cured pigmented intermediate wear layer and a UV light radiation cured topcoat 20 (Abstract and column 22, lines 31-34).

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shalov et al., U.S. Pat. No. 5,830,937 in view of Ehrhart et al., U.S. Pat. No. 5,543,232 in further view of Sawka et al., U.S. Pat. No. 5,405,675 as previously stated in the Office Action submitted on October 1, 2002.

Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ehrhart et al., U.S. Pat. No. 5,543,232 in view of Shalov et al., U.S. Pat. No. 5,830,937 in view of Hallman et al., U.S. Pat. No. 5,800,904 as previously stated in the Office Action submitted on October 1, 2002.

Claims 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shalov et al., U.S. Pat. No. 5,830,937 in view of Ehrhart et al., U.S. Pat. No. 5,543,232 in further view of

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Hallman et al., U.S. Pat. No. 5,800,904 as previously stated in the Office Action submitted on October 1, 2002.

Response to Arguments

Applicants' argument filed October 1, 2002 have been fully considered but they are not persuasive.

On pages 4-6, Applicants argue that Ehrhart does not show a pigmented wear layer and that it is not known in the art that wear layers are pigmented as in the instant invention. Examiner is not persuaded because Shalov is used in combination with Ehrhart to show that it is known that wear layers have been pigmented. Applicants' showing in the technical book "Radiation Curing in Polymer Science & Technology" is not convincing since it only states that "the addition of pigments to radiation-curable systems adds to the complex nature of these systems...there is insufficient data...to be able to say with any certainty what effect the pigment will have." It is not clear how this statement shows that adding pigments to a radiation-curable wear layer is detrimental, as Applicants argue. The book appears to state that any effects that the pigments would have is unknown. Further, nowhere in Ehrhart does the reference teach away from pigmenting the wear layer.

On page 6-7, Applicants argue that Shalov does not teach or suggest the addition of a pigment to a wear layer having the claimed properties of the cured stain resistance or gloss retention. This argument is also not persuasive since Shalov is used in combination with Ehrhart to show that such stain resistance values and gloss retention values are known and desirable in the art of wear layers for surface coverings.

On page 7, Applicants argue that the instant invention is different from Shalov since the instant invention does not require the wear layer to comprise a thermoplastic, plasticizer, and crosslinking agent as Shalov does, while the instant invention only claims the use of radiation curable materials or layers. Applicant also argues that the now amended claims show that the pigmented topcoat or wear layer “consists of” a UV light curable layer, electron beam curable layer, and a combination of the two. This is not persuasive because Applicants have only limited “*the composition*” to those “consisting of” the UV light curable layer, electron beam curable layer, and a combination. Claims 1 and 12 still show that “*the topcoat and radiation cured pigmented layer comprises/each comprise a composition...*” among other compositions. Even if Applicants limited the pigmented topcoat and wear layer to “consist of” a UV light curable layer, electron beam curable layer, and a combination, it would be unclear how the layers would consist solely of these and not with a pigment in order to color it.

Conclusion

Applicant's AMENDMENT necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly T. Nguyen whose telephone number is (703) 308-8176.

The examiner can normally be reached on Monday to Friday, except on every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Kimberly T. Nguyen
Examiner
December 11, 2002

CYNTHIA H. KELLY
SUPERVISOR
TECHNOLOGY CENTER 1700

